



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,974	02/02/2004	Dag Willen	NKTR-34155US1	8989
116 7590 03/31/2009 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			EXAMINER CAZAN, LIVIUS RADU	
			ART UNIT	PAPER NUMBER
			3729	
			MAIL DATE	DELIVERY MODE
			03/31/2009	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/769,974

**Applicant(s)**

WILLEN, DAG

**Examiner**

LIVIOUS R. CAZAN

**Art Unit**

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,6,8-11 and 13-16 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,8,10,11 and 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/21/2008 has been entered.

### ***Specification***

2. The disclosure is objected to because of the following informalities: at page 6, lns. 24-27, the disclosure states the screen "may consist fully or partially of superconducting metallic, and semiconducting materials". It would appear Applicant may have intended to state the screen "may consist fully or partially of superconducting, metallic, or semiconducting materials". As currently presented, the language is not clear, since it could be interpreted to mean the screen may consist fully of the listed materials, i.e. all there should be present, or only partially, i.e. it could consist of only some of the listed materials. Alternatively, as discussed above, the cited passage could imply all three materials must be present. Clarification is requested.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 1, 2, 5, 6, 8, 10, 11, and 13-16** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. **Regarding claim 1**, the phrase "each coaxial layer" (line 18) lacks proper antecedent basis. Likewise in line 16 of **claim 14**.
6. **Regarding claim 11**, see the objection to the specification. Claim 11 is directed to the same recitation as discussed above, and the same issues arise as to possible interpretations of the phrase "consists fully or partially of superconducting, metallic, and semiconducting materials". For rejection purposes, it will be assumed the claim requires at least one but not necessarily all of the listed materials. Also, in the last two lines, the phrase "the electrically insulating material" lacks proper antecedent basis.

***Claim Rejections - 35 USC § 103***

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
8. **Claims 1, 2, 5, 6, 8, 10, 11, and 13-16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuki (JP01231217; please refer to the translation) in view of Long (US3562401).
9. **Regarding claims 1, 2, 5, 6, 8, 11, 14, and 16**, Matsuki discloses (see Figs. 1 and 2) a method for constructing a superconducting cable comprising N phases (u, v, w), the method comprising:

providing each phase in the cable in the form of a number (six) of superconducting phase conductors (16), each only containing superconducting cable wire (4, 8) and an insulation system (10),

classifying the phase-conductors in N-phase groups (see page 5, Ins. 20-22), each N-phase group comprising a phase conductor from each of the N different phases, where N is greater than one (three, in this case), and where the number of N-phase groups is larger than or equal to two (six, in this case),

arranging insulation means in the cable around each phase conductor or between assemblies of phase conductors, and providing that said N-phase groups are electrically insulated from each other (see In. 24 on page 5 to In. 1 on page 6), and

wherein the N-phase groups are arranged in a number of coaxial/concentric groups (two; see Fig. 1; see inner ring having six conductors and outer ring having twelve conductors) having a common axis, either with different phase conductors corresponding to different phases in each coaxial/concentric layer or with each individual phase conductor of a particular phase in a separate coaxial layer,

and wherein the common axis of the coaxial layers is oriented along the length of the superconducting cable.

10. Matsuki discloses substantially the claimed invention, except for the N-phase groups being surrounded by a common electrically conductive screen which is kept at 0 potential and comprises a superconducting, metallic, or semiconducting materials. Matsuki shows layers 12 and 14, which may already provide the claimed function, but Matsuki does not explicitly discuss this.

11. Long teaches a three-phase superconducting cable wherein a metallic grounded screen (42, Fig. 3) serves as a neutral conductor. See col. 3, lns. 60-72.

12. At the time the invention was made, it would have been obvious to one of ordinary skill in the art to provide the cable of Matsuki with such a screen, for the same advantages as in Long.

13. **Regarding claims 10 and 15**, Matsuki in view of Long discloses substantially the claimed invention, except for the number of N-phase groups being larger than 10 or larger than 100.

14. At the time the invention was made, it would have been an obvious matter of engineering design choice to a person of ordinary skill in the art to apply this invention to cables having more than 10 or more than 100 phase groups, because Applicant has not disclosed that these particular values provide an advantage, are used for a particular purpose, or solve a stated problem, and the invention of Matsuki is clearly not limited to a particular number of N-phase groups.

15. Therefore it would have been prima facie obvious to modify the invention of Matsuki and Long to obtain the invention as specified in claims 10 and 15, because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Matsuki and Long.

16. **Regarding claim 13**, as claimed, there is no structural difference between a phase conductor intended to carry a phase current and a phase conductor intended to be a neutral conductor. Choosing which particular conductor to be utilized as a neutral conductor would be part of a method of using the cable, rather than of manufacturing it.

As such, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to pick one or more of the conductors 16 as a neutral conductor, as needed for the particular power transmission line design.

***Response to Arguments***

17. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LIVIUS R. CAZAN whose telephone number is (571) 272-8032. The examiner can normally be reached on M-F 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DAVID P. BRYANT can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. Dexter Tugbang/  
Primary Examiner  
Art Unit 3729

/L. R. C./ 3/25/2009  
Examiner, Art Unit 3729